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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,767	04/11/2001	G. Mark McGregor	P00471-US-1 (17359.0003)	3380
26884	7590	04/14/2009	EXAMINER	
PAUL W. MARTIN NCR CORPORATION, LAW DEPT. 1700 S. PATTERSON BLVD. DAYTON, OH 45479-0001			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3688	
			MAIL DATE	DELIVERY MODE
			04/14/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/832,767	Applicant(s) MCGREGOR ET AL.	
	Examiner Donald L. Champagne	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-25 and 27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-25 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution Reopened

1. Prosecution is hereby reopened following a decision by the BPAI, sufficient cause having been shown by the discovery of a new reference, Chen, disclosed herein. See 37 CFR 1.198. The TC Director's approval is indicated below. A new non-final rejection follows.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 14, 15, 17-19, 21-25 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Chen (US006836792B1).
4. Chen teaches (independent claim 14, 18 and 21) a method for advertising/generating revenue by sending email messages appended with advertising, comprising (as recited by claim 14) the steps of:

transmitting an e-mail message (*send emails*, col. 6 lines 33-38 and Fig. 3) addressed to at least one *email recipient 106* from a first client computer *108* (Fig. 3 and col. 1 lines 45-51) to a host *server 304* (col. 6 lines 59-63) through at least one computer network, wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body (col. 1 lines 27-33);

appending advertisement retrieval software means (*HTML links*, col. 8 lines 19-26) to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements (col. 7 lines 57-64) retrievably stored in a *database of advertisement inserts 340* (col. 8 lines 19-26);

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transmitting the e-mail message from the host server to a second client computer **150** (Fig. 3) through the at least one computer network based upon the e-mail address of the at least one e-mail recipient (col. 8 line 61 to col. 9 line 5); and

displaying the e-mail message on the second client computer (col. 2 lines 21-29), wherein when the e-mail message is first displayed on the second client computer the advertisement software retrieval means is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database for display with the e-mail message on the second client computer (col. 9 lines 2-5).

5. For claim 18, Chen teaches *payment ... to the email system operator* (col. 2 lines 56-60), which reads on "contribution" to "an entity selected by an e-mail user". For claim 21, Chen also teaches "accounting for advertising revenue (*payment*, col. 2 lines 56-60) and "transmitting a return communication (col. 2 line 61 to col. 3 line 3).
6. Chen also teaches at the citations given above claims 17, 22 and 27.
7. Chen also teaches: claims 15, 19, 24 and 25 (col. 6 lines 14-18 and col. 7 line 64 to col. 8 line 14); and claim 23 (col. 6 line 18-20).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US006836792B1) in view of Conley, Jr., et al. (US006434745B1, hereafter "Conley").
10. Claims 16 and 20: Chen does not teach parsing the subject and body of the e-mail message to identify keywords which may be present therein. Conley teaches searching email messages for keywords to target advertising (col. 2 line 67 to col. 3 line 2 and col. 1 lines 42-46), which reads on parsing the subject and body of the e-mail message to identify keywords which may be present therein. Under *KSR v. Teleflex* (82 USPQ 2d 1385), the

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combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Chen teaches using ad targeting as a means to support the use of email. Conley teaches that searching the email itself for keywords can improve ad targeting.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached after Noon on Monday and Wednesday through Friday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
12. The examiner's supervisor, James W. Myhre, can be reached on 571-272-6722. The fax phone number for all *formal* fax communications is 571-273-8300.
13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
14. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

6 April 2009

/Donald L. Champagne/
Primary Examiner, Art Unit 3688

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/Wynn W. Coggins/
Director, TC 3600